

ESTTA Tracking number: **ESTTA719188**Filing date: **01/08/2016**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|---|-------------|-------|
| Name | Luca Maglierie S.r.l. | | |
| Entity | Corporation | Citizenship | Italy |
| Address | Via Pitagora, 10, I-41012 Carpi Modena, ITALY | | |

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| Attorney information | Robyn S. Lederman Brooks Kushman P.C. 1000 Town Center Southfield, MI 48075 UNITED STATES rlederman@brookskushman.com Phone:2483584400 |
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Registration Subject to Cancellation

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|-----------------|--|-------------------|------------|
| Registration No | 3902411 | Registration date | 01/11/2011 |
| Registrant | Baldo Enterprises, Inc. 10 Maple Street Port Washington, NY 11050 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 025. First Use: 2010/05/01 First Use In Commerce: 2010/05/01 All goods and services in the class are cancelled, namely: men's shirts and sweaters |
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Grounds for Cancellation

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| <i>Torres v. Cantine Torresella S.r.l. Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |

Mark Cited by Petitioner as Basis for Cancellation

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|------------------------------------|-----------------------|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | ENZO MANTOVANI | | |
| Goods/Services | sweaters and knitwear | | |

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|-------------|--|
| Attachments | Petition to Cancel - FINAL.pdf(47142 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-------------------|
| Signature | /rlederman/ |
| Name | Robyn S. Lederman |
| Date | 01/08/2016 |

3. Luca produces knitwear under various MANTOVANI labels including ENZO MANTOVANI.

4. Since at least 2010, Petitioner and its licensees or other authorized representatives has owned and used the trademark ENZO MANTOVANI in the USA in connection with knitwear apparel and clothing items. In particular, in March 2010, Respondent, through its related company Kontakt US International Inc. ("Kontakt"), contacted Petitioner regarding selling Petitioner's ENZO MANTOVANI clothing at Costco Wholesale. Petitioner first shipped goods to Kontakt bearing the ENZO MANTOVANI mark in or about May 2010. Over the next several years, Respondent and/or Kontakt continued to buy goods marked with Petitioner's ENZO MANTOVANI mark for sale at Costco Wholesale in the United States. As a mere distributor of Petitioner's ENZO MANTOVANI products, Respondent and/or Kontakt did not gain any rights in Petitioner's ENZO MANTOVANI mark. Rather, any and all goodwill resulting from the sale of Petitioner's ENZO MANTOVANI goods inured to the benefit of Petitioner, not Respondent.

5. Petitioner has expended considerable time, effort and expense in advertising and promoting the ENZO MANTOVANI mark and the goods associated therewith in the United States and worldwide, with the result that the purchasing public has come to know and recognize products of the Petitioner by the ENZO MANTOVANI mark. The Petitioner has exceedingly valuable goodwill established in its ENZO MANTOVANI mark.

6. On May 27, 2010, Respondent filed Trademark Application No. 76703148 for ENZO MANTOVANI in International Class 25 for men's shirts and sweaters. This application issued as registration number 3902411 (the '411 Registration') on January 11, 2011. Upon information and belief, the '411 Registration was an unintentional misspelling of Mr. Mantovani's name.

7. As a basis for the application that became the '411 Registration, Respondent

claimed a first use date of May 2010. Upon information and belief, this date represents the date on which Respondent first purchased ENZO MANTOVANI merchandise from Petitioner.

8. In connection with the application that led to the '411 application, Respondent filed a letter from "Enzo Montovani" stating that he was a living individual and consented to Respondent's registration of his name. Respondent also signed a declaration stating that "no other person, firm, corporation, or association has the right to use the [ENZO MANTOVANI] mark in commerce, either in the identical form thereof or in such near resemblance thereto."

9. Petitioner has for many years offered goods under the mark ENZO MANTOVANI. Petitioner has used and/or licensed others to use the mark ENZO MANTOVANI in connection with men's sweaters.

10. Petitioner desires to register ENZO MANTOVANI for, *inter alia*, men's clothing including sweaters in Class 25.

11. Petitioner is also the owner of abandoned U.S. Trademark Application No. 79106305 for ENZO MANTOVANI for various clothing, including sweaters, in Class 25, which was filed August 5, 2011.

12. Petitioner has expended considerable effort and expense in promoting its mark ENZO MANTOVANI and products associated with this mark, with the result that the purchasing public has come to know and recognize Petitioner's products by this mark. Moreover, Petitioner has an exceedingly valuable good will established in its ENZO MANTOVANI mark.

13. There is no issue as to priority. Petitioner began using its ENZO MANTOVANI trademark in connection with clothing, including men's sweaters, prior to the filing of Respondent's application and alleged date of first use. Moreover, as described above, any goodwill associated with Respondent's or Kontakt's sales of goods bearing Petitioner's ENZO

MANTOVANI mark properly inures to Petitioner, not Respondent.

14. The mark identified in Respondent's registration, ENZO MANTOVANI, is nearly identical to Petitioner's mark, ENZO MANTOVANI, and the marks are used on related goods.

15. Since the mark and goods as described in Respondent's registration are so closely related to Petitioner's mark and goods, confusion and deception as to the origin of Respondent's goods bearing the mark would occur, all to the damage and detriment of Petitioner. Such use would cause confusion in the trade resulting in damage and injury to Petitioner.

16. Respondent's use or registration of the mark ENZO MANTOVANI in connection with "men's shirts and sweaters" is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Respondent with Petitioner, or as to the origin, sponsorship or approval of Respondent's goods by Petitioner.

17. For the foregoing reasons, Petitioner will be damaged by Respondent's continued registration of ENZO MANTOVANI, as shown in the '411 Registration and thus, the '411 Registration should be cancelled

18. Respondent's ENZO MANTOVANI registration should also be cancelled because Respondent committed fraud by making a material misrepresentation to the U.S. Patent and Trademark Office ("USPTO") in obtaining the '411 Registration.

19. More specifically, Respondent filed two false documents with the USPTO to obtain the '411 registration: (1) the letter from "Enzo Montovani" purporting to claim that Mr. "Montovani" consented to the registration (attached hereto as Exhibit A); and (2) the declaration claiming that Respondent was unaware of any party with superior rights in the ENZO MANTOVANI mark (attached hereto as Exhibit B).

20. As discussed above, Mr. Mantovani is the founder of Petitioner. Contrary to the

letter submitted to the USPTO, Mr. Mantovani never consented to Respondent's registration of a trademark bearing his name. Indeed, Mr. Mantovani did not sign the letter shown in Exhibit A, a fact which is confirmed by the misspelling of Mr. Mantovani's name in both the typed and written signatures in the letter. Thus, Respondent's representation that Mr. Mantovani consented to the '411 Registration is false.

21. Respondent's declaration that it was unaware of any parties with superior rights in the ENZO MANTAVANI mark is likewise false. As discussed above, Respondent, through its related company Kontakt, distributed sweaters bearing the ENZO MANTOVANI mark for sale at Costco Wholesale. Accordingly, Respondent was fully aware both of the existence of Petitioner and that Petitioner had superior rights in the ENZO MANTOVANI mark and its statement to the contrary was false.

22. Upon information and belief, Respondent submitted the false Enzo Montovani letter and the false declaration with knowledge of their falsity.

23. Respondent's submission of the false Enzo Montovani letter and the false declaration was material because, absent submission of these documents, the USPTO would not have granted the '411 Registration. More specifically, had Respondent not submitted these two documents, the USPTO would have known that Petitioner had superior rights in the ENZO MANTOVANI mark and, accordingly, that Respondent was not entitled to the '411 Registration.

24. Upon information and belief, Respondent submitted the false Enzo Montovani letter and the false declaration to defraud the USPTO and to obtain a registration to which it was not entitled.

25. Upon information and belief, Respondent acted in bad faith in both registering its ENZO MANTOVANI mark and in submitting the Enzo Montovani letter and the false

declaration.

26. Accordingly, the '411 Registration should be cancelled due to Respondent's fraud on the USPTO.

WHEREFORE, Petitioner, LUCA MAGLIERIE S.r.l., prays that BALDO ENTERPRISES, INC.'s Registration No. 3802411 for the mark ENZO MONTOVANI be cancelled.

The fee required under 37 C.F.R. § 2.6(a)(16) is being paid electronically concurrently with the filing of this Petition to Cancel. If the filing fee is found to be insufficient for any reason, please charge such deficiency to the deposit account.

Respectfully submitted,

BROOKS KUSHMAN P.C.

By: /s/ Robyn S. Lederman
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Attorneys for Petitioner

Dated: January 8, 2016

CERTIFICATE OF SERVICE

I certify that I served:

PETITION TO CANCEL

on January 8, 2016 by:

x mailing (via First-Class mail)

x e-mailing

a copy to:

Barry Manson
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Attorney for Respondent

By: /Robyn S. Lederman/
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